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REEXAM UNIT

In re Application of
Gerard A. Mourour, et al
Reissue Application No. 09/775,069
Filed: February 02, 2001
of Patent No. 5,656,186
Issued: April 08, 1994
Attorney Docket No. UMJ-939-R

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: DECISION ON PETITION UNDER
: 37 CFR 1.182 TO ENTER PROTEST
: UNDER 37 CFR 1.291
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This is in response to a June 11, 2003 petition under 37 CFR 1.182 requesting entry and consideration of a concomitantly submitted protest under 37 CFR 1.291. The § 1.182 petition has been forwarded to this Office for decision.

The § 1.182 petition is granted. The petition fee of \$130 will be charged to Deposit Account No. 08/2240 as authorized in the petition at page 3.

The application is being forwarded to Technology Center 1700 for review of the June 11, 2003 § 1.291 protest.

Background

The instant reissue application was announced in the *Official Gazette* on July 31, 2001.

A final rejection was mailed March 12, 2003. The final rejection rejected the claims only based on a defective reissue oath/declaration, which rejection could be overcome by a supplemental oath/declaration stating that all errors not covered by a previous oath/declaration arose without deceptive intention. [An additional requirement was made to amend the first sentence of the specification to refer to other reissue applications.]

A review of the protest under § 1.291 reveals that it is narrowly focused mostly upon the existence of support in the specification for certain amendments made by the reissue applicant and contains a variety of detailed means for explaining the grounds of protest, including comparison charts, color coding of specification and claim language and commentary that is specific.

The Petition under 37 CFR 1.182

The § 1.291 protest was submitted on June 11, 2003, well after the July 31, 2001 announcement in the *Official Gazette* and well after the 2-month delay period from the date of announcement of the filing of the reissue application in the *Official Gazette* for the recommended submission of protests under § 1.291. The protest is accompanied by the instant petition under § 1.182 to permit entry and consideration of the protest. Petitioner has authorized the \$130 petition fee to be charged to a deposit account. Petitioner, however, argues that the § 1.182 petition is unnecessary for entry and consideration of the § 1.291 protest.

Petitioner cites to MPEP 1441.01 which states:

A protest with regard to a reissue application should be filed within the 2-month period following the announcement of the filing of the reissue application in the *Official Gazette*. ... Where the protest is submitted after the 2-month period, **no petition for entry of the protest under 37 CFR 1.182** is needed with respect to the protest being submitted after the 2 months **unless a final rejection has been issued or prosecution on the merits has been closed for the reissue application.** (Emphasis in quote).

Petitioner notes the mailing of a final rejection on March 13, 2003 [sic] [March 12, 2003] thus appearing to require a petition under § 1.182 to have the protest entered. [Petitioner first notes that the final rejection indicates how it may be overcome, and then states prosecution has not been closed (which appears to be an argument that a § 1.182 petition is not required as prosecution is not really closed), but follows both with a statement that a § 1.182 petition appears to be required, which seems to accept that the close of prosecution exists.]

Petitioner's actual argument for a § 1.182 petition not being needed for consideration of the § 1.291 protest is based on an indication of allowability of the claims as of a November 20, 2002 amendment (presumably based on the March 12, 2003 final rejection indicating how it can be overcome) and the statement in MPEP 1901.04:

A protest with regard to a reissue application should be filed within the 2-month period following announcement of the filing of the reissue application in the *Official Gazette*. **If, for some reason, the protest of the reissue application cannot be filed within the 2-month period provided by MPEP § 1441, the protest can be submitted at a later time.** (Emphasis in quote)

Thus, it is argued by Petitioner that MPEP 1901.04 permits a protest to be filed after the 2-month delay period without a petition under § 1.182 "under the proper circumstances." Petitioner further states that the protest is being submitted at this time since Protestor has "only become aware that the Examiner has recently indicated that claims 46-67 are allowable"

Discussion Re Petition Under 37 CFR 1.182

MPEP 1901.04, in the chapter on protests, sets forth guidelines as to when a protest should be submitted. In regard to reissue applications, it is indicated that while a protest in a reissue application should be filed within the 2-month delay period following announcement of the filing of the reissue in the *Official Gazette*, "[i]f, for some reason, the protest of the reissue application cannot be filed within the 2-month period ... the protest can be filed at a later time" Petitioner relies on this language as supporting the position that a § 1.182 petition is not required under the instant circumstances.

It is to be noted, however, that the possibility of filing a protest at a later time *after the 2-month period*, as recited in MPEP 1901.04, is elaborated upon in the very next sentence of the MPEP that explains that what is meant by "later filed," i.e., where a § 1.182 petition is submitted to extend the 2-month delay period for the Office first acting on the reissue application. Where such

a § 1.182 petition is granted, the protester can be assured that a proper protest will be entered even though it is submitted as a "later time" than the 2-month delay period generally waited. That is not the situation here, where a petition to extend the 2-month delay period was not submitted. Since there was no extension of the 2-month delay period, the present fact situation is governed by MPEP 14441.01, in the chapter on reissue, which states:

A protest with regard to a reissue application should be filed within the 2-month period following the announcement of the filing of the reissue application in the *Official Gazette*. If the protest of a reissue application cannot be filed within the 2-month delay period, the protest can be submitted at a later time. Where the protest is submitted after the 2-month period, no petition for entry of the protest under 37 CFR 1.182 is needed with respect to the protest being submitted after the 2 months **unless a final rejection has been issued or prosecution on the merits has been closed for the reissue application.** (Emphasis added)

Accordingly, as the instant protest under § 1.291 has been submitted after a final rejection has issued, a grantable petition under 37 CFR 1.182 is required to have the protest made of record and considered.

In any case, petitioner appreciates that there must at least be present "proper circumstances." Petitioner's apparent argument is that its only recently becoming aware of the allowance of claims meets the permissive statement in MPEP 1901.04 that "[i]f, for some reason, the protest of the reissue application cannot be filed within the 2-month period provided by MPEP § 1441, the protest can be submitted at a later time. The Office does not view waiting until there is an allowance of claims to submit a protest as falling under the category of "proper circumstances." **Protests are to be submitted before prosecution begins, and a third party should not wait until the prosecution is over to then request that the Office, in effect, restart prosecution by the consideration of a protest.** See MPEP 1901.06 ("If the protest is submitted after the ... mailing of a notice of allowance under 37 CFR 1.311 ... it should not be entered in the application filed.")

Decision Re Petition Under 37 CFR 1.182

35 U.S.C. 122(c) provides that "The Director shall establish appropriate procedures to ensure that no protest ... to the grant of a patent on an application may be initiated after publication of the application" As set forth immediately below in the discussion of § 1.291, a reissue application is not published but announced and therefore 35 U.S.C. 122(c) does not act as a statutory bar to the submission of a protest in a reissue application at any stage of its pendency.

37 CFR 1.291(a)(1) states in-part that protests by a member of the public will be referred to the examiner (and considered) if the protest is submitted "prior to the date the application was published or the mailing of a notice of allowance under § 1.311, whichever occurs first...." The rule does not specifically identify reissue applications, but its generic reference to applications requires the inclusion of reissue applications. The recitation to the date the application was published is not construed to contemplate appearance of a reissue application in the *Official Gazette* as such appearance is only an announcement of the filing of the reissue application with certain bibliographic information to identify the application and not a publication of the application contents. MPEP 1430.

As pointed out above, MPEP 14441.01, states that "[w]here the protest is submitted after the 2-month period, no petition for entry of the protest under 37 CFR 1.182 is needed with respect to the protest being submitted after the 2 months unless a final rejection has been issued or prosecution on the merits has been closed for the reissue application. Thus, if the present petition under §1.182 is grantable, the protest will be entered and considered.

In this instance, the Technology Center having responsibility for examination of the instant application has preliminarily reviewed the protest under § 1.291 to the extent needed to determine what resources would be required to substantively review the protest and has not indicated any opposition to the grant of the instant § 1.182 petition.

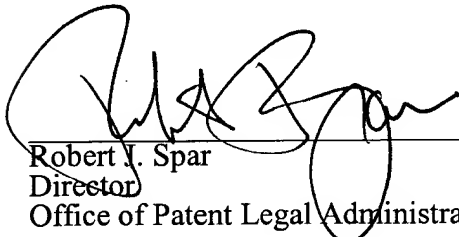
Based on a review of the record as the whole, and the nature of the protest and its presentation, the petition under § 1.182 is granted. The \$130 petition fee will be charged to deposit account no. 08/2240 as authorized on page 3 of the petition.

Protest under § 1.182

The petition under 37 CFR 1.182 is granted. The June 11, 2003 protest under 37 CFR 1.291 is not directed at prior art, but rather to matters relating to § 1.173, including § 1.173(c) as to support for amendments. An issue is also raised in regard to 35 U.S.C. 112, first paragraph, written description.

In view of the decision granting the petition under 37 CFR 1.182, the protest is being forwarded to Technology Center 1700 for treatment of the protest.

Any communications related to this matter should be directed to Hiram H. Bernstein, Senior Legal Advisor, Office of Patent Legal Administrator, who may be reached by phone at (703) 305-8713.



Robert J. Spar
Director
Office of Patent Legal Administration